Appl. No.: 09/916,543
Amendment and Response dated June 11, 2007

Docket No.: 085804 . 013500

REMARKS

Claims 1, 2, 4, 7 to 17, 20 to 77, 79, 80, 82 to 108 and 110 to 124 are the pending claims, of which Claims 1, 11, 16, 24, 29, 31, 75, 107, 108, 111 and 112 are independent. Claims 1, 11, 16, 17, 24 , 29, 31, 75, 107, 108, 111 and 112 are amended. Reconsideration and further examination are respectfully requested.

At page 2 of the Office Action, it is alleged that there is no "antecedent basis" in the specification for the language "absent user editing," and contends that a negative limitation must be literally expressed in the negative in the disclosure in order to satisfy 35 U.S.C. § 112, first and second paragraphs.

Applicants respectfully disagree with the position taken in the Office Action. As is set forth by the courts, including Ex parte Parks, 30 USPQ 1234, 1236 (Bd. Pat. App. & Int. 1993) and In re Grasselli, 232 USPQ 393 (Bd. Pat. App. & Int. 1983) cited by the Examiner, there is no literal requirement under 35 U.S.C. § 112, first paragraph. Furthermore and with respect to § 112, second paragraph, MPEP § 2175.03(i) states, in relevant part:

> [t]he current view of the courts is that there is nothing inherently
> ambiguous or uncertain about a negative limitation. So long as the
> boundaries of the patent protection sought are set forth definitely, albeit
> negatively, the claim complies with the requirements of 35 U.S.C. § 112,
> second paragraph.

However, for the sole purpose of advancing prosecution and without in any way conceding the correctness of the position taken in the Office Action, Applicants are amending the claims to remove the limitation at issue. As amended, the claims recite that the script code (or a reference thereto) is embedded (or inserted) in a web-page prior to providing the web-page in response to a web-page request.

By the Office Action, the claims are rejected under 35 U.S.C. § 103(a). More particularly, Claims 1, 16, 29, 75, 107 and 108 are rejected over U.S. Patent No. 6,125,385 (Wies) and U.S. Patent No. 6,337,696 (Lindhorst), Claims 2, 4, 9 to 13, 17, 22 to 26, 30 to 74, 76, 77, 79, 80, 82, 85 to 106 and 110 to 124 are rejected over Wies, Lindhorst, and U.S. Patent No. 5,996,003 (Namikata), Claims 7, 8, 20, 21, 83 and 84 are rejected over Wies, Lindhorst, Namikata and U.S. Patent No. 5,708,780 (Levergood), and Claims 14, 15, 27 and 28 are rejected

over Wies, Lindhorst, Namikata and U.S. Patent No. 6,128,649 (Smith). Reconsideration and withdrawal of the rejection are respectfully requested.

By way of just one non-limiting example, the script code can be embedded into a web page used in an educational setting by a teacher and her students to add functionality to the web page, which functionality allows the teacher to make markings in the displayed text of a text book, which markings are communicated to each of the student's displayed textbook text, so that the students are able to receive real-time, interactive instruction over the Internet and without the need for specialized or expensive hardware. In response to a request for the web-page, the web-page is retrieved, and script code that is absent from the retrieved web-page is embedded into the web-page prior to the web-page being provided in response to the web-page request. The web-page is provided to the teacher and student with the interactive functionality embedded in the web-page.

Turning to the specific language of the claims, Claim 1 recites a method of adding interactive functionality to a web-page. According to the method, a request for the web-page is received from a first user. The requested web-page is retrieved, and script code is embedded within the requested web-page to add interactive functionality to the web-page. The step of embedding the script code is performed prior to providing the web-page in response to the web-page request by parsing the requested web-page to determine an appropriate location to embed script code that is absent from the requested web page prior to the parsing. The requested web-page having the embedded script code is then provided to the user.

In accordance with the method of Claim 1, script code is embedded in a web-page prior to providing the requested web-page in response to the web-page request by parsing the web-page to determine an appropriate location to embed the script code absent from the requested web-page prior to the parsing.

The Examiner concedes that Wies fails to teach, suggest or disclose embedding script code into a requested web-page by parsing the requested web-page to determine an appropriate location to embed the script code. It follows then that Wies also cannot teach, suggest or disclose the claimed parsing and embedding being performed prior to providing the web-page to the user in response to a web-page request.

Lindhorst describes an interactive editing process by which a user can edit a document opened and provided to the user in an editing environment shown in Figures 1 and 2. After the

document is provided to the user for editing, the process rebuilds and saves the document and then ends. According to Lindhorst's editing process, as shown in Figure 3, Lindhorst opens the document at step 106 and parses the document to separate the elements contained in the document at step 110. After steps 106 and 110 are performed to open and parse the document, Lindhorst provides the document to the user in the editing environment shown in Figures 1 and 2 at step 112. At step 145, a new or existing script is displayed for the user. When the user is finished editing the document, as determined at step 148, the document is rebuilt and saved at step 150, and processing ends. If it is assumed, *arguendo*, that step 150 of Figure 3 corresponds to embedding script code (an assumption that is in no way conceded), the embedding of script code is performed after the document has been opened and provided to the user for editing in the user interface shown in Figures 1 and 2. According to Lindhorst, step 150 is performed after the document is displayed for the user in Figures 1 and 2, and once step 150 is completed, the document is saved and the process ends. It is clear from Lindhorst that Lindhorst inserts the script code after the document is provided to the user, and that after the script code is inserted in the document, the document is saved and the process ends. Lindhorst fails to teach, suggest or disclose embedding script code in a web-page prior to providing the web-page in response to a web-page request by parsing the web-page to determine an appropriate location to embed the script code absent from the requested web-page prior to the parsing.

The Office Action concedes that Wies fails to teach, suggest or disclose parsing a web-page to determine an appropriate location to embed the script code. In light of the concessions made in the Office Action, it follows then that Wies cannot teach, suggest or disclose embedding script code within a requested web page prior to providing the web-page in response to the web-page request by parsing the requested web page to determine an appropriate location to embed script code that is absent from the requested web page prior to said parsing.

Since multiple elements are missing from both Wies and Lindhorst, Applicants respectfully submit that the § 103(a) rejection should be withdrawn, and such action is respectfully requested. Furthermore, for at least the foregoing reasons, Claims 1, 11, 16, 24, 29 and 31 (and the claims that depend therefrom) are believed to be in condition for allowance. In addition, for at least the same reasons, Claims 75, 107, 108, 111 and 112 (and the claims that depend therefrom) are believed to be in condition for allowance.

With regard to the dependent claims, it is submitted that they recite additional elements that are not taught by the art applied. As just one example, Claim 9 recites providing the requested web-page to first and second users, each of the first user and the second user has a computing device having a display on which the web-page is displayed, the first user's computing device having a cursor control device to control movement of a cursor on the first user's display, and wherein the script code embedded within each user's web-page adds interactive functionality to the web page by displaying one or more movements of the first user's cursor on the web-page of the second user.

The portions of Wies cited by the Examiner fail to teach, suggest or disclose script code embedded into each user's web-page adding interactive functionality to the web page by displaying one or more movements of the first user's cursor on the web-page of the second user. As is described in Wies, col. 2, lines 2, lines 59 to 61 and col. 7, lines 36 to 46, a force feedback device 50 provides tactile sensations so that the user can "feel" the sensations. Wies describes that the force feedback device 50 can be a mouse device that can be used by the user to manipulate a pointer icon on the user's own display device. However, a device that provides tactile feedback and allows the user to move a cursor on the user's own display fails to teach, suggest or disclose script code embedded in a user's web-page that adds interactive functionality by displaying one or more movements of the user's cursor on the web-page of the second user. Col. 6, lines 47 to 60 of Wies describes a client machine 14 directly communicating force feedback commands to client machine 16. However, this portion of Wies is limited only to communicating commands to manipulate the force feedback device to provide tactile sensation, which is not the same as displaying one or more movements of one user's cursor on the web-page of the another user. Nothing in the applied art teach, suggests or discloses at least the features of embedding script code in a web-page prior to providing the web-page in response to a web-page request, the script code embedded in the web-page provided to first and second users adds interactive functionality to the web-page by displaying one or more movements of the first user's cursor on the web-page of the second user.

Based at least on the foregoing discussion, Claim 9 is patentably distinct from the applied art. For at least the same reasons, Claims 22, 92 and 93 are patentably distinct from the applied art. Claims 36, 40, 41, 92 and 93, which depend from Claim 9, are patentably distinct from the applied art for at least the same reasons discussed.

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Claim 4 recites the method of Claim 1, wherein in the embedding step which parses the requested web-page to determine an appropriate location to embed the script code, the web-page is parsed to identify a header included in the requested web-page, such that the script code that is absent from the requested web-page prior to parsing the web-page is embedded in the header of the requested web-page.

The Office Action cites Wies, col. 15, lines 64 to col. 16, line 3 and Lindhorst, col. 15, lines 52 to 54. The cited portion of Wies consists of a discussion of objects, such as headings, contained in a web page and applying generic force effects to such objects. The cited portion of Lindhorst merely states that scripts present in an HTML document can be found in the body and head sections of the HTML document. Applying force effects to a given object is not the same as embedding script code in a web-page by parsing the web-page to identify a header included in the web-page as the appropriate location to embed the script code. Lindhorst's indication that script code can be found in a head section of an HTML document further fails teach, suggest or disclose the claimed embedding step, which embeds the script code in a header identified by parsing the web-page to identify the header as an appropriate location to embed the script. Nothing in the cited portions of Wies and Lindhorst teaches, suggests or discloses embedding script code within a requested web-page by parsing the requested web-page to identify a header included in the requested web-page as an appropriate location to embed the script code, such that the script code that is absent from the requested web-page prior to parsing the web-page is embedded in the header of the requested web-page prior to providing the web-page in response to the web-page request. Claim 4 is therefore patentably distinct from the applied art. Claims 79 and 82 are also patentably distinct from the applied art for at least the reasons discussed.

Claim 10 recites the embedded script code of Claim 1 embedded within the web-page of first and second users adding interactive functionality to the web-page by analyzing the web-page to assign a same unique identifier to an element of the web-page of first and second users, transmitting an identifier of a particular element that is the subject of actions by the first user to the second user's computing device, and locating the corresponding element on the second user's web page by using the identifier, so that the actions of the first user can be communicated to the second user.

The cited portions of Wies, i.e., col. 4, lines 47 to 60 and col. 14, lines 63 to 65 fail to teach, suggest or disclose at least the element of transmitting an identifier of a particular element

that is the subject of actions by the first user to a second user's computer device. The cited portions of Wies describe a predefined graphical identifier that indicates to a user that the web page provides force effects. An identifier identifying that a web page provides force effects is not the same as the claimed identifier that identifies a particular element that is the subject of actions by a user. At col. 14, lines 63 to 65, Wies focuses on the force feedback device and the ability for a user to use the device to control the cursor on the user's own computer. The cited portion fails to even mention an identifier of a particular element, let alone an identifier of a particular element that is the subject of actions by the first user being transmitting to a second user's computing device.

The cited portions of Namikata fail to remedy the deficiencies noted with respect to Wies. The cited portions of Namikata describe transmitting "x" and "y" coordinates of a participant's pointer. The cited portions of Namikata fail to disclose the same unique identifier being assigned to an element of the web-page of first and second users, let alone an identifier of a particular element that is the subject of actions by one user, transmitting an identifier of a particular element that is the subject of actions by the first user to the second user's computing device, and/or locating the corresponding element on the second user's web page using the identifier, so that the actions of the first user can be communicated to the second user

Nothing in the applied art teaches, suggests or discloses script code embedded within the web-page of first and second users adding interactive functionality to the web-page by analyzing the web-page to assign a same unique identifier to an element of the web-page of first and second users, transmitting an identifier of a particular element that is the subject of actions by the first user to the second user's computing device, and locating the corresponding element on the second user's web page by using the identifier, so that the actions of the first user can be communicated to the second user.

Since multiple elements of Claim 10 are missing from the applied art, Claim 10 is patentably distinct from the applied art. Claim 49, which depends from Claim 10, is patentably distinct from the applied art for at least the same reasons discussed. Claims 23, 45 to 48, 50 to 53, 57 to 59, 62 to 65, 97 to 106, 113 and 114 are patentably distinct from the applied art for at least the reasons discussed.

Claim 12 recites that cursor coordinate data received from one of the first and second users and transmitted to the other of the first and second users is point data or draw data. The

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Office Action cites col. 9, lines 4 to 11 and lines 50 to 59 of Namikata, and states that "the cursor coordinate data is one point data." The cited portions of Namikata describe a "POINTER_MOTION" message, which is transmits "x" and "y" coordinate values, and "POINTER_INVISIBLE" and "POINTER_VISIBLE" messages, which indicate whether or not to display the pointer. Nothing in the cited portion teaches, suggests or discloses cursor coordinate data being point data or draw data. Since the applied art fails to teach, suggest or disclose at least the identified elements of the claim, Claim 12 is patentably distinct from the applied art. Claims 25, 37 to 39, 42 to 44, 56, 67, 68, 71, 72, 89 to 91 and 94 to 96 are also patentably distinct from the applied art for at least the same reasons.

In accordance with Claims 116, 118, 120, 122 and 124, the embedded script code (or the inserted reference) within the first user's web-page differs from that within the second user's web-page. The Office Action cites col. 3, lines 40 to 48 and col. 4, lines 49 to 59 of Wies.

The cited portions of Wies describe using an authoring tool to customize force feedback effects for objects in a web page, that the customized force feedback effects can be downloaded when the web page is downloaded, and that force feedback effects can be assigned to objects in standard web pages to customize the standard web pages. Wies' ability to assign customized force feedback effects and to assign customized force feedback effects to objects in a standard page in order to customize the page fails to teach, suggest or disclose script code embedded in a web-page, let alone script code embedded with a web-page provided to a first user differing from the script code embedded with a web-page provided to a second user. Since the applied fails to teach, suggest or disclose multiple elements of the claims, Claims 116, 118, 120, 122 and 124 are patentably distinct from the applied art.

Claims 115, 117, 119, 121 and 123 recite that the embedded script code (or the inserted reference) within the first user's web-page is the same as that within the second user's web-page. The Office Action uses the same grounds for rejection as cited against Claim 2. However, nothing can be found in the cited portions of the applied art that teaches, suggests or discloses embedded script code (or the inserted reference) within the first user's web-page is the same as that within the second user's web-page. Since the applied fails to teach, suggest or disclose multiple elements of the claims, Claims 115, 117, 119, 121 and 123 are patentably distinct from the applied art.
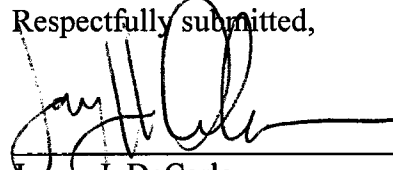
In view of the foregoing, the entire application is believed to be in condition for allowance.

Should matters remain which the Examiner believes could be resolved in a telephone interview, the Examiner is requested to telephone the Applicants' undersigned attorney. Alternatively, since it is believed that the claims of the present application are in condition for allowance, the Examiner is respectfully requested to issue a Notice of Allowance at the Examiner's earliest convenience.

The applicants' attorney may be reached by telephone at 212-801-6729. All correspondence should continue to be directed to the address given below, which is the address associated with Customer Number 32361.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-1561. Please ensure that the Attorney Docket Number is referenced when charging any payments or credits for this case.

Respectfully submitted,

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